

This Page Is Inserted by IFW Operations
and is not a part of the Official Record

BEST AVAILABLE IMAGES

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images may include (but are not limited to):

- BLACK BORDERS
- TEXT CUT OFF AT TOP, BOTTOM OR SIDES
- FADED TEXT
- ILLEGIBLE TEXT
- SKEWED/SLANTED IMAGES
- COLORED PHOTOS
- BLACK OR VERY BLACK AND WHITE DARK PHOTOS
- GRAY SCALE DOCUMENTS

IMAGES ARE BEST AVAILABLE COPY.

**As rescanning documents *will not* correct images,
please do not report the images to the
Image Problem Mailbox.**

The opinion in support of the decision being entered today is not binding precedent of the Board.

Filed by: Mark Nagumo
Administrative Patent Judge
Mail Stop Interference
P. O. Box 1450
Alexandria, VA 22313-1450
Tel: 703-308-9797
Fax: 703-305-0942

Filed
7 July 2003

22
Paper

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

FAXED

JUL 7 - 2003

ROLAND **ANDREE**,
MARK WILHELM DREWES, MARKUS DOLLINGER,
and HANS-JOACHIM SANTEL

**PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES**

Junior Party
(Patent No. 6,251,828),

v.

RALF **KLINTZ**, PETER SCHAEFER,
GERHARD HAMPRECHT, ELISABETH HEISTRACHER,
HANS-JOSEF WOLF, KARL-OTTO WESTPHALEN,
MATTHIAS GERBER, UWE KARDORFF, HELMUT WALTER,
and KLAUS GROSSMANN

Senior Party
(Application No. 09/733,554).

Patent Interference 105,039 (NAGUMO)

RESPONSE TO KLINTZ REQUEST FOR CLARIFICATION

Klintz seeks clarification of the DECISION ON ANDREE PRELIMINARY MOTION 1 AND FINAL JUDGMENT (Paper 31), mailed June 27, 2003, in the form of an additional Order. (Paper 31 at 2.) In particular, Klintz believes the Board overlooked an order stating that Klintz is entitled to a patent containing certain claims in its involved application.

The Board's decision in this case is, fundamentally, that there is no interference-in-fact, i.e., that there is no interfering subject matter. Thus, we held that Andree's patent is no impediment to granting Klintz the claims of its application, or vice-versa. *Cf. Case v. CPC Int'l, Inc.*, 730 F.2d 745, 750, 221 USPQ 196, 200 (Fed. Cir. 1984). An interference is a vehicle to determine which of two (or more) parties claiming the same invention was the first to make that invention. 35 U.S.C. § 135(a). If the patentee loses the interference, its involved claims are cancelled. 35 U.S.C. § 135(a). The Director of the United States Patent and Trademark Office is then in a position to determine whether to issue a patent to the applicant. If the applicant loses the interference, its involved claims stand rejected by the agency. *Id.*

The patentability of Klintz's claims 1-7, 12, 13, 15, 16, 26-30, 36, 37, 39, 40, and 43-51 of Klintz's involved application has not been raised on the present record. Andree did not file a motion challenging the patentability of any of these claims; nor did an Administrative Patent Judge "become aware of a reason why a claim designated to correspond to the count may not be patentable" (37 CFR § 1.641(a)). The Board, therefore, has had no occasion to rule on the patentability of these claims.

Klintz's citations of 37 CFR § 1.658 and the Commissioner's commentary on motions under 37 CFR § 1.633(b) have not escaped our notice. Rule 658(a), by its terms, refers to judgments as to counts: "A judgment as to a count shall state whether or not each party is entitled to a patent containing the claims in the party's patent or application which correspond to the count." In the present case, we determined that there was no proper count. Because there is, in this case, no count, there can be no judgment as to a count, and Rule 658 is inapposite. As for the Commissioner's comments on Rule 633(b), such commentary is not binding except to the extent that it reflects the language of the Rule. Rule 633(b) contains no requirements as to the form of the decision. When, in an interference, the patentability of various claims has been contested and a full interference has been conducted, it may be helpful to clarify the status of such claims. In this case, when the patentability of the indicated claims has not been contested, and no motion has been opposed, comment such as that called for by Klintz would be superfluous.

On termination of this interference, Klintz's involved application will be returned to the examiner for further action not inconsistent with the decision of the Board. Should the examiner - or Klintz - become aware of any ground on which the patentability of any claim is called into question, that issue should be fully explored prior to issuance of a patent.


Order

In consideration of the foregoing findings of facts and considerations, it is:

ORDERED that Klintz's request for clarification is GRANTED;

FURTHER ORDERED that Klintz's request for an additional order is DENIED; and

FURTHER ORDERED that a copy of this decision be entered in the administrative record of Andree's 6,251,828 patent and of Klintz's 09/733,554 application.



MARK NAGUMO
Administrative Patent Judge

Interference 105,039
cc (via facsimile and first class mail):

Attorney for Andree

(Real party in interest, Bayer CropScience AG, a subsidiary of Bayer AG)

Kurt G. Briscoe, Esq.
Howard C. Lee, Esq.
NORRIS McLAUGHLIN & MARCUS, P.A.
220 East 42d Street
New York, NY 10017

Tel: (212) 808-0700
Fax: (212) 808-0844

Attorney for Klintz

(Real party in interest, BASF AG)

Herbert B. Keil, Esq.
Norman G. Torchin, Esq.; Jason D. Voight, Esq.;
Lesley E. Shaw, Esq.
KEIL & WEINKAUF
1101 Connecticut Ave, N.W.
Washington, DC 20036

Tel: (202) 659-0100
Fax: (202) 659-0105